



UNITED STATES PATENT AND TRADEMARK OFFICE

ST
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,806	12/14/1999	EUGENE M. LEE	K7565.0002/P002	2979
24998	7590	06/26/2002		
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L STREET NW WASHINGTON, DC 20037-1526			EXAMINER	
			QUELLETTE, JONATHAN P	
		ART UNIT	PAPER NUMBER	
		3629		
DATE MAILED: 06/26/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary	Application No.	Applicant(s)
	09/460,806	LEE, EUGENE M.
	Examiner	Art Unit
	Jonathan Ouellette	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12/14/1999.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
 4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 209A, 209B, 242, 252, 409, 411, and 426. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “208B” has been used to designate both filing documents to Associate B and filing documents to RO/US. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to because no label appears on the drawing for the workstation (421). Also, the printer is described in the specification as label 424, but it is actually labeled 442 in the drawing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to because of the following informalities: the “Brief Description of Drawings” section is miss-titled as “Detailed Description of Preferred Embodiments.”

Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3629

8. Claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 18-19 of copending Application No. 09/409,524. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.
9. The original U.S. Patent Application No. 09/409524 describes a facility "whereby an applicant (or his representative) may file corresponding applications in multiple jurisdictions using multiple associates while automating the preparation of filings in accordance with jurisdiction – and/or associate-specific requirements and/or procedures." The instant application goes on to describe both quoting fees and completing transactions, specifically "one or more of debiting a deposit accounts, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system" in claims 18 and 19.
10. The copending U.S. Patent application No. 09/460806 further describes detailed methods in which to complete the quotations and transactions for services mentioned above. These methods are inherent in the first described facility, and thus are anticipated by the first application.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3, 5-10, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 5,819,092) in view of Hunter et al. (US 6,298,327).
13. As per claim 1, Ferguson discloses a computer implemented method for transacting a service, the method comprising: presenting a user with one or more services and associated fees; and in response to selection by the user of one or more of the services, initiating performance of the selected one or more services, and coincident therewith, transacting the associates one or more fees (Abstract, C4 L28-32, C4 L51-57, C8 L63-67, C9 L1-9, C29 L36-55, C38 L55-59, C39 L1-8, Figure 16, Figure 24).
14. Ferguson does not teach the above mention services being an intellectual property service.
15. Hunter teaches a computer-implemented method for operating an intellectual property service (Abstract, C4 L46-55, C6 L2-11, C6 L16-28, C31 L8-14).
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a method for operating an intellectual property service as disclosed by Hunter in the system disclosed by Ferguson, for the advantage of providing a method of transacting an intellectual property service.
17. As per claim 3, Ferguson and Hunter disclose wherein the fee transacting includes one or more of authorizing a debit of deposit account, supplying an invoice, and processing the fee transaction via a payment system (Ferguson: Abstract, C9 L1-9, C29 L45-55, Figure 16).

18. As per claim 5, Ferguson and Hunter disclose automatically initiating the presenting of intellectual property services in response to a docket event for a particular intellectual property manner (Hunter: Abstract, C3 L53-67, C4 L15-20, C32 L3-25, C39 L38-49).
19. As per claim 6, Ferguson and Hunter disclose retrieving intellectual property application information from a data store (Hunter: C32 L1-2, C33 L4-9, Fig. 2); and calculating the fees based on the intellectual property application information (Ferguson: Abstract, C30 L1-18, C34 L20-61, C40 L31-33).
20. As per claim 7, Ferguson and Hunter disclose supplying information encoding the selected one or more services and the transacted one or more fees for use in an accounting system (Ferguson: Abstract, C8 L55-67, C9 L1-53, Figure 2).
21. As per claim 8, Ferguson discloses a computer implemented method for transacting intellectual property annuity, maintenance or renewal fee payments, the method comprising: presenting a user with a set of one or more matters and associated annuity, maintenance or renewal fee payments; and in response to selection by the user of one or more of the matters and associated fee payments, initiating performance of the selected fee payments, and coincident therewith, initiating an associated payment transaction between the user and an intellectual property annuity, maintenance or renewal fee payment service (Abstract, C4 L28-32, C4 L51-57, C8 L55-67, C9 L1-9, C29 L36-55, C38 L55-59, C39 L1-8, Figure 2, Figure 16, Figure 24).
22. Ferguson does not disclose presenting, based on docket data, a user with a set of one or more intellectual property matters.

23. Hunter teaches presenting, based on docket data, a user with a set of one or more intellectual property matters (Hunter: Abstract, C3 L53-67, C4 L15-20, C32 L3-25, C39 L38-49).
24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a method for operating an intellectual property service as disclosed by Hunter in the system disclosed by Ferguson, for the advantage of providing a method of transacting an intellectual property service.
25. As per claim 9, Ferguson and Hunter disclose wherein the presenting with a set of intellectual property matters and associated fee payments and the initiating performance of the selected fee payments are performed by the fee payment service (Ferguson: Abstract, C8 L55-67, C9 L1-53, C15 L40-59, Figure 2).
26. As per claim 10, Ferguson and Hunter disclose wherein at least the presenting with a set of intellectual property matters and associated fee payments is performed by an intermediary separate from the fee payment service (Ferguson: Abstract, C8 L55-67, C9 L9-11, C15 L40-59, Figure 2).
27. As per claim 21, Ferguson discloses a computer program product encoded in a computer readable medium, the computer program product comprising: fee transaction code executable to transact one or more fees associated with the selected one or more intellectual property services coincident with performance thereof by a corresponding one or ones of the information services (Abstract, C4 L28-32, C4 L51-57, C8 L4-14, C8 L55-67, C9 L1-9, C29 L36-55, C38 L55-59, C39 L1-8, Figure 1, Figure 2, Figure 16, Figure 24).

Art Unit: 3629

28. Ferguson does not teach selection code executable to select from amongst one or more intellectual property services supported by one or more information services therefore.
29. Hunter teaches selection code executable to select from amongst one or more intellectual property services supported by one or more information services therefore (C6 L16-28, C31 L41-51, C32 L58-61).
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selection code executable to select from amongst one or more intellectual property services supported by one or more information services therefore as disclosed by Hunter in the system disclosed by Ferguson, for the advantage of producing computer program product encoded in a computer readable medium, with the option and ability of selecting from amongst one or more intellectual property services.
31. As per claim 22, Ferguson and Hunter disclose wherein the selection code and the fee transaction code are all executable on a same processor (Ferguson: C8 L63-68, C9 L1-9).
32. As per claim 23, Ferguson and Hunter disclose a computer program product encoded by or transmitted in at least one computer readable medium selected from the set of a disk, tape or other magnetic, optical, or electronic storage medium and a network, wire line, wireless or other communication medium (Hunter: Abstract, C6 L16-21, C31 L59-60, C32 L26-67).
33. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Ferguson.

Art Unit: 3629

34. As per claim 24, Hunter discloses an intellectual property filing preparation system comprising: means for selecting from amongst one or more intellectual property services (Abstract, C6 L16-28, C31 L41-51); means for initiating performance of the selected one or more intellectual property services (Abstract, C4 L46-55, C6 L2-11, C6 L16-28, C31 L8-14).
35. Hunter does not teach means for transacting fees coincident with the performance of the selected one or more intellectual property services.
36. Ferguson teaches means for transacting fees coincident with the performance of the selected one or more intellectual property services (Ferguson: Abstract, C8 L55-67, C9 L1-53, C15 L40-59, Figure 2).
37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a means for transacting fees coincident with the performance of the selected one or more intellectual property services as disclosed by Ferguson in the system disclosed by Hunter, for the advantage of providing a method of transacting an intellectual property filing preparation system.
38. Claims 2, 4, 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson in view of Hunter as applied to claims 1, 3, 5-10, 21-23 above, and further in view of Bezos et al. (5,819,092).
39. As per claim 11 and 15, Ferguson discloses a method of operating an information service (information system) to facilitate fee transactions relating to services (Hunter teaches the said services including intellectual property services), the method comprising: registering at least one target jurisdiction and a computer readable encoding of fees for services

performed therein; and distributing at least a subset of the specific fees to an intellectual property service (portal) user for use in transacting associated intellectual property services.

40. Neither Ferguson nor Hunter teaches the registering for each of plural associates (target nodes), and using a respective one or ones of the associates when transacting associated intellectual property services.
41. Bezos teaches the registering for each of plural associates (target nodes), and using a respective one or ones of the associates when transacting associated intellectual property services (Abstract, C1 L56-61, C24 L1-4).
42. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the registering for each of plural associates (target nodes), and using a respective one or ones of the associates when transacting associated intellectual property services, as disclosed by Bezos in the system disclosed by Hunter, in the system disclosed by Ferguson, for the advantage of operating and transacting an information service to facilitate preparation of intellectual property documents with the ability of users to select from a list of registered associates, in which to file the intellectual property documents.
43. As per claim 2, Ferguson, Hunter, and Bezos teach wherein the intellectual property services include one or more of paying an annuity of maintenance fee (Ferguson C8 L63-67, C9 L1-9), making an intellectual property filing on behalf of the user and preparing target jurisdiction-specific and associate specific form documents (Hunter: Abstract, C4 L46-55, C6 L2-11, C6 L16-28, C31 L8-14), (Bezos: C1 L56-61, C24 L1-4).

44. As per claim 4, Ferguson, Hunter, and Bezos teach presenting a user with a set of target jurisdictions and respective associates therefore, wherein the fees associated with a particular one or ones of the intellectual property services are further particularized by target jurisdiction and respective associate (Ferguson: Abstract, C4 L28-32, C4 L51-57, C8 L55-67, C9 L1-53, C15 L40-59).
45. As per claim 12, Ferguson, Hunter, and Bezos teach wherein the distribution is responsive to selection by the intellectual property service of one or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates (Hunter: Abstract, C4 L46-55).
46. As per claim 13, Ferguson, Hunter, and Bezos teach wherein the distribution includes periodic supply to the intellectual property service of the computer readable encoding of fees for services (Ferguson: Abstract, C4 L28-32, C4 L51-57, C8 L55-67, C9 L1-53, C15 L40-59), (Hunter: Abstract, C4 L46-55).
47. As per claim 14, Ferguson, Hunter, and Bezos teach wherein the distribution is encoded by or transmitted in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electronic storage medium in a network, wire line, wireless or other communications medium (Hunter: Abstract, C6 L16-21, C31 L59-60, C32 L26-67).
48. As per claim 16, Ferguson, Hunter, and Bezos teach wherein for a particular selected target jurisdiction and associate combination, the particularized fees include: target jurisdiction specific fees for an intellectual property filing therein; and fees of the

selected associate for performing the selected at least one intellectual property service (Ferguson: Abstract, C4 L28-32, C4 L51-57, C8 L55-67, C9 L1-53, C15 L40-59).

49. As per claim 17, Ferguson, Hunter, and Bezos teach wherein the originating node includes a computer of the managing attorney or intellectual property owner; and wherein the target nodes include computers of respective associates configured to electronically receive at least partial instructions concerning an intellectual property filing from the managing attorney or intellectual property owner via the intellectual property service portal (Hunter: C8 L36-40, C2 L54-67, C3 L1-11, Fig 3).

50. As per claim 18, Ferguson, Hunter, and Bezos teach wherein the originating node includes a web browser (Ferguson: C4 L18-27, C7 L59-67, C8 L1-52, Figure 1); wherein in the intellectual property service portal includes a web server (Hunter: C5 L54-63, C31 L5-7, C31 L59-60); and wherein the selection of at least one intellectual property service, the supplying of the particularized fees, and the transacting of the particularized fees are achieved at least in part, using internet protocol traffic between the web browser and the web server (Ferguson: C7 L36-42, C8 L55-67, C9 L1-67).

51. As per claim 19, Ferguson, Hunter, and Bezos teach wherein the intellectual property filing portal if further responsive to registration by the associates of their particularized fees; wherein the supplied particularized fees include those registered by the selected associates (Bezos: Abstract, C1 L56-61, C24 L1-4).

52. As per claim 20, Ferguson, Hunter, and Bezos teach wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications

network segment, and a virtual private network (Hunter: Abstract, C7 L61-67, C31 L5-7, C31 L59-60, Fig 1), (Ferguson: C7 L58-67, C39 L33-34, Fig 1).

Conclusion

53. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

54. The following patent is cited to further show the state of the art with respect to application processing systems in general:

U.S. Pat. No. 5,995,947 to Fraser et al.

U.S. Pat. No. 6,115,690 to Wong

U.S. Pat. No. 6,195,646 to Grosh et al.

U.S. Pat. No. 6,236,972 to Shkedy et al.

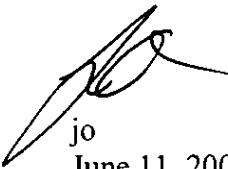
U.S. Pat. No. 6,385,594 to Lebda

U.S. Pat. No. US 2001/0000044 A1 to Lin

55. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.

56. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

57. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


jo
June 11, 2002



